

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of: Chaganti

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| S.No. 09/307,752 | ART UNIT: 3624 |
| FILED: MAY 10, 1999 | EXAMINER: CHARLES R. KYLE |
| TITLE: METHOD AND SYSTEM FOR SALE OF SHARES OF INTANGIBLE PROPERTY RIGHTS... | DOCKET NO: PSCO-004 |

TRANSMITTAL OF APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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APR 08 2004

GROUP 3600

Sir:

Submitted herewith in triplicate is Appellant's Appeal Brief in support of the Notice of Appeal filed on December 2, 2003 in the above-referenced case. A check for \$160 for the Appeal Brief is enclosed. Duplicate copies of this sheet are enclosed.

Respectfully submitted,

April 2, 2004


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APPEAL BRIEF

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Sir:

This is an appeal from Examiner's Final Rejection of September 2, 2003.

This Brief is submitted in support of the Notice of Appeal filed December 2, 2003.

REAL PARTY IN INTEREST

The real party in interest is Pennar Software Corporation of Virginia.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

Claims 7-44 stand rejected. This appeal is from the rejection of all the currently rejected claims.

STATUS OF AMENDMENTS

No amendments have been filed subsequent to the final Office Action.

Upon a clarification of the legal issues presented herein, Applicant requests leave to amend to narrow certain claims to achieve allowance.

SUMMARY OF THE INVENTION

The invention is a novel method of sale of certain unconventional intangible property rights at an electronic marketplace. First, the property rights are securitized. Then the property rights are marketed either in whole or in the form of shares of the property. Bids are received and the highest bidder is sold the property, which may not include possessory interest. Derived values of the property are also marketed. The specification states that the invention is directed toward a marketplace for sale of intangible property that is other than corporate stocks or bonds, or commodities. The intangible property may be intellectual property, such as patent, trademark, know-how, copyright etc. It may also be any one or a collection of rights, such as the right to collect a judgment, right to payments such as child support payments, right to a license, lease, right of way, a person's time, etc. In another aspect, the item sold can be a unit of service.

Another aspect the invention is directed toward shares and derivative values or shares or combinations of the intangible property, special services or rights. Proceeds from the intangible property, for example, income derived from the asset, are distributed according to the terms of the securitized instrument.

A computerized marketplace utilizing a computer network is used to implement the invention. The computerized marketplace lists the various types of property or services that can be listed under a symbol, such as a stock ticker symbol, and the public is invited to bid. In alternative embodiments, the market is limited to members who participate in the bidding process.

PROCEDURAL HISTORY AND THE EXAMINER'S REASONS

Each of the independent claims incorporates the term “intangible property” interest or a type of special property interest that is not offered for sale on a publicly traded exchange. The innovation lies in creating an electronic marketplace for those property interests that are not currently tradeable. An advantage in creating a tradeable marketplace is creating liquidity to the owners of the property interests. By securitizing the property interests and selling shares of thereof, the intangible property or shares thereof is converted into a tradeable security.

The Examiner rejected all the currently pending claims based on USP 5,873,071 to Ferstenberg et al., (submitted by Applicant in an IDS) individually or in combination with Brett et al., Crain's New York Business, Dictionary of Finance and Investment, Stallaert et al., or Harrington et al. under 35 USC §§ 102(e) or 103(a) as being anticipated or obvious.

The critical point of debate appears to be one of terminology and not of substance. Examiner appears to concede that if a different term than “intangible property” is used to describe the type of property interests for which an electronic

marketplace is invented then the claims would overcome the cited Ferstenberg reference. Examiner relies on a dictionary of financial terms to construe the word “intangible” and thereafter states that in so far as a corporate stock was defined in that dictionary as “intangible,” notwithstanding any redefinition applicant provided in the specification, the “plain meaning” as understood by the Examiner from the dictionary would render all the instant independent claims unpatentable, and further in a combination of references stated above, the remaining claims would be unpatentable as well. Applicant filed a request for continued examination (RCE). Applicant argued only the point of law, but the Examiner was not convinced. Applicant did not amend any claims save for claim 39, and the case was finally rejected once again. Applicant filed a notice of appeal on December 2, 2003.

ISSUES

The issues on appeal are:

Issue 1: Whether the Examiner erred in rejecting claims 7, 17, 23-24 and 33 under 35 U.S.C. §102(e) as unpatentable over Ferstenberg et al., U.S. Patent # 5,873,071 (Ferstenberg).

Issue 2: Whether the Examiner erred in rejecting claim 16 under 35 U.S.C. §103(a) as unpatentable over Ferstenberg.

Issue 3: Whether the Examiner erred in rejecting claim 39 under 35 U.S.C. §103(a) as unpatentable over Harrington et al.

Issue 4: Whether the Examiner erred in rejecting claims 8-9, 26-27, 34 and 35 under 35 U.S.C. §103(a) as unpatentable over Ferstenberg et al. in view of Crain's New York Business.

Issue 5: Whether the Examiner erred in rejecting claims 10, 12, 15, 20, 28, 30, 36 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Ferstenberg et al. in view of Brett et al.

Issue 6: Whether the Examiner erred in rejecting claims 13, 14, 18, 19 and 31-32 under 35 U.S.C. § 103(a) as being unpatentable over Ferstenberg et al. in view of the Dictionary of Finance and Investment Terms.

Issue 7: Whether the Examiner erred in rejecting claims 11, 21-22, 29 and 37 under 35 U.S.C. § 103(a) as being unpatentable over Ferstenberg et al. in view of Stallaert et al.

Issue 8: Whether the Examiner erred in rejecting claims 40-41 under 35 U.S.C. § 103(a) as being unpatentable over Ferstenberg et al. in view of Crain's New York Business.

Issue 9: Whether the Examiner erred in rejecting claims 42 and 44 under 35 U.S.C. § 103(a) as being unpatentable over Harrington et al. in view of Brett et al.

Issue 10: Whether the Examiner erred in rejecting claim 43 under 35 U.S.C. § 103(a) as being unpatentable over Harrington et al. in view of Stallaert et al.

GROUPING OF CLAIMS

Each claim is argued separately and therefore each claim stand or fall independently of any other claim.

ARGUMENT

ISSUE 1: THE EXAMINER ERRED IN REJECTING CLAIMS 7, 17, 23-24 AND 33 UNDER 35 U.S.C. §102(E) AS UNPATENTABLE OVER FERSTENBERG ET AL., U.S. PAT. NO. 5,873,071 (FERSTENBERG).

I. The Examiner Erred in Applying the Law on Claim Construction

A principal issue in this case appears to be the legal distinction between the maxims “a patentee is his own lexicographer” and “limitations from the specifications are not read into the claims.” The difference of opinion between the applicant and the examiner is that applicant asserts that the phrase “intangible property” has been defined in the application as meaning things other than corporate stock and interests derived from corporate stock. The Examiner, on the other hand, resorted to extrinsic evidence, that is, a Dictionary of Finance and

Investment Terms, and relied on the definition of the word “intangible” as including corporate stock.

Examiner argues that the “plain meaning” of the claims prevails in an analysis of the scope of the claim language. But the Examiner would like the “plain meaning” understood from sources such as a dictionary of financial terms. Thus, relying on the “plain meaning” of the term “intangible property” as defined in a dictionary of financial terms, Examiner argues that the mention of “intangible property” in Ferstenberg is the same as “intangible property” in the instantly claimed invention. Examiner further argues that to refer to the specification is to read “limitations” from the specification into the claim language, and therefore argues that it was not the law under *In re Van Geuns*, 988 F.2d 1181, 26 U.S.P.Q. 2d 1057 (Fed. Cir. 1993). Thus, the difference of opinion can be restated as whether understanding the claim term with resort to the specification is the same as reading the claim limitations into the claim language.

Because there is a difference in opinion on the terminology and the conflict of the maxims as presented above, this Board is requested to clarify how the conundrum may be resolved.

Applicant respectfully disagreed with the Examiner’s analysis of the law of claim construction. Applicant believes that the Examiner stopped his analysis at “plain meaning” and sought extrinsic evidence (*i.e.*, dictionary) to explain terms before he looked at the intrinsic evidence (*i.e.*, Specification) to see if Applicant chose to be his own lexicographer. Almost the entire discussion on this

Application has been over this point. Accordingly, Applicant respectfully discusses his arguments below.

A. In Construing a Claim, One Cannot Ignore Intrinsic Evidence.

In construing claims, the analytical focus must begin and remain centered on the language of the claims themselves, for it is that language that the patentee chose to use to “particularly point[] out and distinctly claim[] the subject matter which the patentee regards as his invention.” *See Interactive Gift Express v. CompuServe*, 256 F.3d 1323; 2001 U.S. App. LEXIS 15711; 59 U.S.P.Q.2D (BNA) 1401 (Fed. Cir. 2001) (citing 35 U.S.C. § 112, P 2).

“It is well-settled that, in interpreting an asserted claim, the court should look first to the intrinsic evidence of record, *i.e.*, the patent itself, including the claims, the specification and, if in evidence, the prosecution history. Such intrinsic evidence is the most significant source of the legally operative meaning of disputed claim language.” *See id.*, (citing *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 U.S.P.Q.2D (BNA) 1573, 1576 (Fed. Cir. 1996)). All intrinsic evidence is not equal however. *See Vitronics*, at 1582, 39 U.S.P.Q.2D (BNA) at 1576-77 (delineating a hierarchy among the intrinsic evidence).

As a starting point, we give claim terms their ordinary and accustomed meaning as understood by one of ordinary skill in the art. *See Hockerson-Halberstadt, Inc. v. Avia Group Int’l, Inc.*, 222 F.3d 951, 955, 55 U.S.P.Q.2D (BNA) 1487, 1490 (Fed. Cir. 2000). Accordingly, a technical term used in a patent is interpreted as having the meaning a person of ordinary skill in the field of the

invention would understand it to mean. *See Interactive Gift Express, Inc. v. CompuServe Inc.*, 256 F.3d 1323 (Fed. Cir. 2001).

The first mandate is, therefore, to consult the claims. *See Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 U.S.P.Q.2D (BNA) 1816, 1819 (Fed. Cir. 1995). Then we look to the rest of the intrinsic evidence, beginning with the specification and concluding with the prosecution history, if in evidence. *See Vitronics*, 90 F.3d at 1582, 39 U.S.P.Q.2D (BNA) at 1576-77 (delineating this order); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979, 34 U.S.P.Q.2D (BNA) 1321, 1329 (Fed. Cir. 1995) (“Claims must be read in view of the specification, of which they are a part.”), *aff’d*, 517 U.S. 370 (1996); *Bell Communications Research*, 55 F.3d at 620, 34 U.S.P.Q.2D (BNA) at 1819 (noting first the mandate to consult the claims, followed by inspection of the rest of the specification).

If the claim language is clear on its face, then our consideration of the rest of the intrinsic evidence is restricted to determining if a deviation from the clear language of the claims is specified. A deviation may be necessary if “a patentee [has chosen] to be his own lexicographer and use terms in a manner other than their ordinary meaning.” *Vitronics*, 90 F.3d at 1582, 39 U.S.P.Q.2D (BNA) at 1576. A deviation may also be necessary if a patentee has “relinquished [a] potential claim construction in an amendment to the claim or in an argument to overcome or distinguish a reference.” *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 973, 979, 52 U.S.P.Q.2D (BNA) 1109, 1113 (Fed. Cir. 1999). If however the

claim language is not clear on its face, then our consideration of the rest of the intrinsic evidence is directed to resolving, if possible, the lack of clarity.

In *Interactive Gift Express*, the Court stated, “Resort to the specification is particularly important in this case because IGE has conceded that the claim limitations in dispute include technical terms that are defined in the Specification.” But the court immediately cautioned that while one might rely on the definitions of a claim term one should not read limitations in the Specification into the claim language. *See Interactive Gift Express*, 256 F.3d 1323; 2001 U.S. App. LEXIS 15711, *16-*17 (Fed. Cir. 2001) (“However, in looking to the specification to construe claim terms, care must be taken to avoid reading limitations appearing in the specification . . . into [the] claims. We recognize that there is sometimes a fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification. In locating this “fine line” it is useful to remember that we look to the specification to ascertain the meaning of the claim term as it is used by the inventor in the context of the entirety of his invention, and not merely to limit a claim term.”) [Internal quotations and citations omitted].

In *Bell Atlantic Network Services, Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258; 2001 U.S. App. LEXIS 18572; 59 U.S.P.Q.2D (BNA) 1865 (Fed. Cir. 2001), the court stated that an applicant might act as his own lexicographer by using the specification to define terms either expressly or “by implication.” *Id.* (citing *Vitronics*, 90 F.3d at 1582, 39 U.S.P.Q.2D (BNA) at 1577). The court further stated that the ordinary meaning of the non-technical

term “mode” was sufficiently broad and amorphous that the scope of the claim language could be reconciled only with recourse to the written description. *Id.* (citing *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1187, 48 U.S.P.Q.2D (BNA) 1001, 1005 (Fed. Cir. 1998)). [Emphasis added]

Regarding redefining a claim term in such a way as to change its meaning, the court stated “in redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim term so as to put one reasonably skilled in the art on notice that the patentee intended to so redefine the claim term. [citations omitted] We have also stated that the specification must exhibit an ‘express intent to impart a novel meaning’ to claim terms. [citations omitted.] [Emphasis added] However, a claim term may be clearly redefined without an explicit statement of redefinition. Indeed, we have specifically held that the written description of the preferred embodiments ‘can provide guidance as to the meaning of the claims, thereby dictating the manner in which the claims are to be construed, even if the guidance is not provided in explicit definitional format.’ (citing *Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1344, 58 U.S.P.Q. 2d (BNA) 1059, 1065 (Fed. Cir. 2001)). In other words, the specification may define claim terms ‘by implication’ such that the meaning may be ‘found in or ascertained by a reading of the patent documents.’” *Id.* (citing *Vitronics*, 90 F.3d at 1582, 1584 n.6, 39 U.S.P.Q. 2d (BNA) at 1577, 1578 n.6).

In CCS Fitness, the court clarified the use of the specification to rebut the presumption that a claim term carries its ordinary meaning:

“First, the claim term will not receive its ordinary meaning if the patentee acted as his own lexicographer and clearly set forth a definition of the disputed claim term in either the specification or prosecution history. Second, a claim term will not carry its ordinary meaning if the intrinsic evidence shows that the patentee distinguished that term from prior art on the basis of a particular embodiment, expressly disclaimed subject matter, or described a particular embodiment as important to the invention. Third . . . a claim term also will not have its ordinary meaning if the term ‘chosen by the patentee so deprives the claim of clarity’ as to require resort to the other intrinsic evidence for a definite meaning. Last, as a matter of statutory authority, a claim term will cover nothing more than the corresponding structure or step disclosed in the specification, as well as equivalents thereto, if the patentee phrased the claim in step- or means-plus-function format.” 288 F.3d at 1366-67, 62 USPQ2d at 1662-63 (citations omitted).

The *Interactive Gift Express* court stated, “If the meaning of the claim limitations is apparent from the totality of the intrinsic evidence, then the claim has been construed. If however a claim limitation is still not clear, we may look to extrinsic evidence to help resolve the lack of clarity. Relying on extrinsic evidence to construe a claim is ‘proper only when the claim language remains genuinely ambiguous after consideration of the intrinsic evidence.’ *See id.* The court further stated, “Such instances will rarely, if ever, occur.” *Id.*

Importantly, the *Interactive Gift Express* court clarified the role of dictionaries such as those the Examiner relies in this case. “Dictionaries, which are a form of extrinsic evidence, hold a special place and may sometimes be

considered along with the intrinsic evidence.” *See id.* (citing *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1459, 46 U.S.P.Q. 2d (BNA) 1169, 1177 (Fed. Cir. 1998) (en banc); *Vitronics*, 90 F.3d at 1584 n.6, 39 U.S.P.Q. 2d (BNA) at 1578 n.3 (stating that, although technically extrinsic evidence, the court is free to consult dictionaries at any time to help determine the meaning of claim terms, “so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents”)). [Emphasis added]

Extrinsic evidence may always be consulted, however, to assist in understanding the underlying technology. *See Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1309, 51 U.S.P.Q. 2d (BNA) 1161, 1168 (Fed. Cir. 1999) (“Consultation of extrinsic evidence is particularly appropriate to ensure that [a judge’s] understanding of the technical aspects of the patent is not entirely at variance with the understanding of one skilled in the art.”). But extrinsic evidence may never be used “for the purpose of varying or contradicting the terms in the claims.” *See Markman*, 52 F.3d at 981, 34 U.S.P.Q.2D (BNA) at 1331.

Throughout the construction process, it is important to bear in mind that the viewing glass through which the claims are construed is that of a person skilled in the art. *See Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387, 21 U.S.P.Q. 2d (BNA) 1383, 1386 (Fed. Cir. 1992).

From the foregoing, the law of claim construction can be understood to include the following steps.

(a) First one should look at the claim language itself.

(b) If the claim language is clear, then one can resort to intrinsic evidence only to determine if the applicant (patentee) used the claim to express a deviation from the clear language of the claim terms. An applicant may change the traditionally understood meaning to a claim term expressly or by implication.

(c) Dictionaries may help, but they cannot contradict the explicit definition of claim terms as provided in intrinsic evidence.

(d) If intrinsic evidence is clear, then there is no need for extrinsic evidence.

(e) Extrinsic evidence may be used to understand the state of the art, but can never be used to contradict the meaning of claim terminology as provided by the patentee.

(f) In the process of claim construction, the claims are construed to make sense to a person skilled in the art.

The Federal Circuit applied these principles in a series of recent decisions on claim construction.

In *Interactive Gift Express v. Compuserve*, 256 F.3d 1323; 2001 U.S. App. LEXIS 15711; 59 U.S.P.Q. 2d (BNA) 1401 (Fed. Cir. 2001), the Federal Circuit stated that the claim term “point of sale location” included a customer’s home based on the definition or explanation of the term in the specification. The Federal Circuit further ruled that the district court impermissibly read limitations—that were not in the claim language itself—from the specification to construe the claim term “point of sale location.” The Court found that because the meaning of the term “point of sale location” was clear from the intrinsic evidence, there was no

need to consider extrinsic evidence. *See Interactive Gift Express*, 2001 U.S. App. LEXIS 15711 at *22-24 (citing *Vitronics*, 90 F.3d at 1583, 39 U.S.P.Q. 2d (BNA) at 1577) (“In those cases where the public record unambiguously describes the scope of the patented invention, reliance on any extrinsic evidence is improper.”)

Similarly, with respect to the claim term “Information Manufacturing Machine” the court stated that it did not convey a clear meaning to one skilled in the art. Therefore, the Federal Circuit looked at the specification to interpret the term, but stated that it would be improper to read limitations from the specification into a claim term.

In *Bell Atlantic Network Services, Inc.*, the Federal Circuit looked to the specification to construe the term “mode” and said consistent usage of “mode” throughout the specification defined the term “by implication.” (“[T]he written description ‘provide[d] guidance as to the meaning of the claims, thereby dictating the manner in which the claims [were] to be construed, even if the guidance [was] not provided in explicit definitional format.’” (citing *Scimed*, 242 F.3d at 1344, 58 U.S.P.Q. 2d (BNA) at 1065)). In the same case, the court construed the scope of the terms “selectively changing” and “selectively operating” by consulting the specification rather than relying on the “plain language”.

More recently, in *Rambus, Inc. v. Infineon Technologies, AG*, 318 F.3d 1081; 65 U.S.P.Q. 2d (BNA) 1705 (Fed. Cir. 2003), the Court reaffirmed that inventors might act as their own lexicographers and use the specification to supply implicitly or explicitly new meanings for claim terms. Finding that the claim term

“read request” did not have unambiguous ordinary meaning to one of skill in the art, the court stated that the district court’s construction of the meaning of this term conflicted with that of the specification. The court looked at the specification and dependent claims to arrive at the correct meaning of the disputed term. Regarding the meaning of the term “bus”, the Federal Circuit ruled that the term was well-understood by persons of skill in the art, and that the district court erred in limiting the term to a “multiplexed bus”, though the claim language itself did not so limit.

As to the applicant being his own lexicographer, in a recent case, the Federal Circuit found that the term “co-micronization” prior to the filing of that patent application, and stated “Had that term not been explicitly defined in the ‘726 patent specification, we might well agree with the appellants that that term could simply mean ‘micronized with or together’ and would not necessarily exclude the presence of ingredients not specifically recited in the claim. However, the phrase ‘co-micronization of fenofibrate and a solid surfactant’ is in fact explicitly defined at column 1, lines 35-38, of the ‘726 patent, as ‘micronization of an intimate mixture of fenofibrate and a solid surfactant.’ Hence, this is a case in which the patentee has ‘chosen to be his own lexicographer,’ and the district court did not err by reading the patentee’s definition from the specification into the claim.” *See Abbott Labs, v. Novopharm, Ltd.*, 323 F.3d 1324; 66 U.S.P.Q.2D (BNA) 1200 (Fed. Cir. 2003).

The Internal Revenue Code defines the corporate stock as capital asset, similar to undeveloped land. Under the tax code, intangible property is a business intangible, for example, good will, copyright, know-how, trade mark, trade secret, patent and similar other things. Thus, it is not clear why a dictionary of financial terms would be the sole source upon which the Examiner relies to arrive at the definition of the word “intangible”.

B. The Term “Intangible” is used with Different Meanings in the Application and the Cited Art.

Applicant believes that a feature of the instant disclosure presents a novel and nonobvious method to devise a marketplace for certain property interests that are not currently available for purchase or sale. These include, but are not limited to, sale in intangible property interests such as chattel paper, various kinds of rights, obligations, and intellectual property (e.g., patents, trademarks, trade secrets, and copyrights), and several derived property interests. See Specification.

Ferstenberg, on the other hand, uses the word “intangibles” but defines these as “intangibles, such as securities (stocks, bonds, and options) commodity futures, collateralized mortgage obligations, and pollution rights, as well as tangibles, such as copper or soy beans.” See Ferstenberg at Background of the Invention [Emphasis supplied].

Accordingly, Applicant believes that the subject matter described in Ferstenberg and the instant disclosure are not the same. In fact, in the section entitled “Background” Applicant distinguished the described property interests,

which form the subject matter of the instant invention from those described by Ferstenberg.

In section 5.3, Ferstenberg et al. state that their invention was

“particularly adapted to the exchange of financial commodities, and in this section the preferred implementation adapted to this exchange is described. Financial commodities include such intangibles as stocks and bonds, as well as contracts for the future exchange of tangible or intangible commodities, known as options. Preferably, these commodities are traded in financial markets during which publicly available bid and ask prices are established.”

Nowhere does Ferstenberg allude to the type of subject matter described in the Applicant’s disclosure. Applicant respectfully requests the Examiner to reconsider in view that the mere usage of the word “intangible” in the Applicant’s disclosure and the cited art does not indicate that the Applicant and Ferstenberg discussed the same subject matter. Clearly, the same word was used to mean different things.

Ferstenberg et al. describe their invention to be an intermediated exchange of commodities, and further, “a computer system (a computer-based machine including hardware and software) for intermediated exchange that is capable of facilitating exchanges of multiple commodities for multiple participants according to their goals.” See Summary of the Invention. [Emphasis supplied]. Ferstenberg is directed toward a “negotiation protocol specifies how to search through possible combinations of exchanges between participants in order to identify the combination that balances the goals of the intermediary with the goals of the participants in the exchange. The protocol addresses both the determination of

which commodities are exchanged among participants and the amount of each commodity exchanged. It also provides a solution for the competitive equilibrium problem as it is applied to intermediated exchanges. A computer program constructed according to this protocol, together with accompanying hardware, permits participants electronically and automatically to carry out negotiations for the transfer of commodities through an intermediary.” See Summary. This is clearly not the essence of Applicant’s disclosure.

In view that Applicant’s invention and Ferstenberg are directed toward different subject matter, Applicant believes that Ferstenberg does not anticipate or render obvious the instantly claimed invention. Accordingly, Applicant respectfully requests reconsideration and a withdrawal of this rejection.

In the instant application, the applicant has clarified in the specification that the invention disavowed securities such as corporate stocks and bonds and stated that the particular types of property that were marketed in the instantly described electronic marketplace included other property rights. Thus, Ferstenberg, which is directed toward a marketplace for “intangibles, such as securities (stocks, bonds, and options) commodity futures, collateralized mortgage obligations, and pollution rights, as well as tangibles, such as copper or soy beans” (*see* Abstract) is directed toward trading different types of property rights than those contemplated in the instantly claimed invention. Ferstenberg consistently uses the term “intangible”—at 8 places in the application (including once in the claims)—to mean “stocks and bonds”. Thus, it is respectfully submitted that Ferstenberg could not have

contemplated the types of property rights to be marketed in the electronic marketplace as claimed in the instant application.

Because there is a different usage of the term “intangible” between Ferstenberg and the instant application, applicant respectfully requests that the Board to reverse the Examiner in light of the law on claim interpretation presented above. Because Ferstenberg is believed to be inapplicable, and because it does not motivate or suggest one of ordinary skill in the art to combine Ferstnberg with one or more of the other references at the time the instant invention was made—nor do the other references suggest or motivate that each of them could be combined with Ferstenberg—all the claims as presented are believed to be patentable.

C. Applicant Requests Leave to Amend Upon Clarification of the Legal Issues

Though the Examiner relied on the “plain meaning” as defined by a dictionary of his choosing, he did not address the legal arguments presented above, and therefore Applicant requests clarification of the law on this issue and further leave to amend should an amendment is deemed necessary.

ISSUE 2: THE EXAMINER ERRED IN REJECTING CLAIM 16 UNDER 35 U.S.C. §103(A) AS UNPATENTABLE OVER FERSTENBERG.

Applicant hereby incorporates by reference the arguments under Issue 1 above as if that argument were fully set forth herein.

In rejecting claim 16 over Ferstenberg, Examiner concedes that Ferstenberg does not directly disclose the subject matter therein, but argued that it would have been obvious to invite the owners of property interests to register their property.

Examiner has provided no evidence of any motivation or suggestion for such an obvious implication in Ferstenberg. Further, the claim language “inviting an owner of a property interest to register their property” would not have been obvious to Ferstenberg or any one or more of the prior art methods because the publicly traded stock exchanges do not invite an owner of a corporate stock to register the property via the Internet. That such an invitation would facilitate securitizing and subsequent sale of the securitized intangible property is not contemplated or disclosed in Ferstenberg. Unless one uses the present invention a blueprint for a hindsight reconstruction of Ferstenberg in light of the instant claims, one who reads Ferstenberg would not be able to come with the instant claims. Accordingly, it is submitted that claim 16 would not have been obvious to one skilled in the art at the time the instant invention was made.

ISSUE 3: THE EXAMINER ERRED IN REJECTING CLAIM 39 UNDER 35 U.S.C. §103(A) AS UNPATENTABLE OVER HARRINGTON ET AL. (USP 6,161,099)

Harrington (USP 6,161,099) was filed as a regular “utility” application on May 29, 1998, whereas the instant application was filed on May 10, 1999. However, Harrington claims the benefit of a provisional patent application filed on May 29, 1997. Harrington, which was filed within one year of the instant filing date of the instant application would not itself qualify as a 102(e) reference, that is, unless those portions upon which the Examiner relies were present in the

provisional patent application as well. There is no indication in the Examiner's rejection that Harrington qualifies for such an effective filing date.

Examiner relies on Harrington for the proposition that Harrington et al "disclose the invention substantially as claimed" in claim 39. But Harrington states its invention as follows.

An apparatus and process for conducting auctions, specifically municipal bond auctions, over electronic networks, particularly the Internet, is disclosed. The auctioneer maintains a web site from which information about bonds to be auctioned can be obtained. A user participates in the auction by accessing the web site via a conventional Internet browser and is led through a sequence of screens that perform the functions of verifying the user's identity, assisting the user in preparing a bid, verifying that the bid conforms to the rules of the auction, displaying to the user during the course of the auction selected bid information regarding bids received and informing the bidder how much time remains in the auction. The user may be given the option of confirming the accuracy of his bid before submitting the bid. The auctioneer is able to review bidding history, determine the winner and notify the winner over the network, and display selected auction results to bidders and observers over the network.

Nowhere in this description or in the entire disclosure do Harrington et al use the word "intangible" or the word "share." Harrington et al describe an electronic auction system implemented on a computer network. Yet Examiner relies solely on Harrington to reject claim 39, which is clearly distinguishable over that reference. Examiner cites the following language in Harrington at col. 6, lines 20-26, for example, to argue that Harrington discloses the steps of "computing a

plurality of shares in an intangible property interest” and “outputting a prospectus for shares in said intangible property interest”:

Bids in municipal bond auctions may be complex because of the need to bid on a package of multiple bonds having differing principal amounts and maturity dates. Comparing one's prospective bid against the current highest bid involves more than a simple comparison of two numbers. It is difficult to do this comparison rationally in real-time without computational assistance.

Examiner concedes that Harrington et al do not specifically disclose that the property interest is formed in a single intangible property interest. Yet, the Examiner found that Harrington et al taught sufficiently to motivate or suggest to one of ordinary skill in the art to apply the “complexity of bidding” to the instant claim 39. It is respectfully submitted that the cited language does not show what the Examiner has seen therein. Claim 39, therefore, is patentable over Harrington et al. The Board is requested to reverse and remand.

ISSUE 4: THE EXAMINER ERRED IN REJECTING CLAIMS 8-9, 26-27, 34 AND 35 UNDER 35 U.S.C. §103(A) AS UNPATENTABLE OVER FERSTENBERG ET AL. IN VIEW OF CRAIN’S NEW YORK BUSINESS.

As to the applicability of Ferstenberg to the instant patent application, Applicant hereby incorporates by reference the arguments under Issue 1 above as if that argument were fully set forth herein.

The Examiner states that Crains’s “discloses that intellectual property can be sold in a computer-implemented method and that the intellectual property can be patents, trademarks or copyrights at the Abstract.” But there is no motivation or suggestion either in Ferstenberg or in Crain’s to combine the two references in

the manner the Examiner combines to deem claims 8-9, 26-27, and 34-35 unpatentable. These claims are dependent on the independent claim 7, which is believed to be patentable in view of the discussion presented with respect to that claim in Issue 1. In addition, because the examiner showed no evidence that intellectual property can be marketed in an electronic marketplace in the manner claimed in claim 1, it is submitted that claims 8-9, 26-27 and 34-35 would not have been obvious to one of skill in the art at the time the instant invention is made. The Board is requested to reverse and remand.

ISSUE 5: THE EXAMINER ERRED IN REJECTING CLAIMS 10, 12, 15, 20, 28, 30, 36 AND 38 UNDER 35 U.S.C. § 103(A) AS BEING UNPATENTABLE OVER FERSTENBERG ET AL. IN VIEW OF BRETT ET AL.

As to the applicability of Ferstenberg to the instant patent application, Applicant hereby incorporates by reference the arguments under Issue 1 above as if that argument were fully set forth herein.

The only reason the Examiner combined Ferstenberg with Brett is that Brett described an online ticket sales. Thus, Examiner believes that Brett rendered claims 10, 12, 15, 20, 28, 30, 36 and 38 were rendered obvious because, a ticket is a license or a right to use a place, and therefore all the claims are rendered obvious in view of Brett. Applicant respectfully disagrees because no motivation or suggestion to combine Ferstenberg with Brett is provided within the references themselves, and because Examiner engaged in a hindsight reconstruction of the

claims from the references, which is not the proper method of examination. The Board is requested to reverse. In the alternative that the Board agrees with the Examiner, Applicant respectfully requests leave to strike those portions of these claims and present them in such a way as to permit further examination or allowance.

ISSUE 6: THE EXAMINER ERRED IN REJECTING CLAIMS 13, 14, 18, 19 AND 31-32 UNDER 35 U.S.C. § 103(A) AS BEING UNPATENTABLE OVER FERSTENBERG ET AL. IN VIEW OF THE DICTIONARY OF FINANCE AND INVESTMENT TERMS.

As to the applicability of Ferstenberg to the instant patent application, Applicant hereby incorporates by reference the arguments under Issue 1 above as if that argument were fully set forth herein.

The Examiner argues that the derivation of one intangible property interest from another intangible property interest would have been obvious to one of skill in the art in view that the Dictionary “discloses such an interest as a secondary mortgage loan at page 541.” Applicant submits that all inventions are combinations of already known elements or things but that should not be the reason to reject the instant claims 13, 14, 18, 19 and 31-32 because no motivation or suggestion to combine the references is found in the references themselves. The Board is requested to reverse and remand.

ISSUE 7: THE EXAMINER ERRED IN REJECTING CLAIMS 11, 21-22, 29 AND 37 UNDER 35 U.S.C. § 103(A) AS BEING UNPATENTABLE OVER FERSTENBERG ET AL. IN VIEW OF STALLAERT ET AL.

As to the applicability of Ferstenberg to the instant patent application, Applicant hereby incorporates by reference the arguments under Issue 1 above as if that argument were fully set forth herein.

Stallaert et al describes the patented method as follows.

The present invention allows market participants to exchange bundles of assets, including assets in different asset classes. A market participant may value the bundle as an entity, alleviating the need to attempt to attain a value objective in the aggregate by valuing and trading assets individually. A bundle of assets to be traded is entered, wherein proportions of each asset to be traded in units of a specified bundle size are provided by the market participant. Assets to be acquired by one market participant are matched against the same asset which other market participants are seeking to dispose. An exchange of bundled assets among market participants, in units of the bundles themselves is effected when the exchange satisfies a predetermined set of criteria.

Nowhere does Stallaert use the word “intangible.” Stallaert uses the word “share” to mean a portion of the seller’s commission and not in the manner that is described in the instant application. Stallaert does not does not disclose or claim any of the features of the rejected claims, for example, “offering for sale a share in said intangible property interest.” See claim 22. Yet Examiner argues that the claims 11, 21-22, 29 and 37 would have been obvious to one of skill in the art at the time of the invention based on a combination of Stallaert and Ferstenberg. The Board is requested to reverse and remand.

ISSUE 8: THE EXAMINER ERRED IN REJECTING CLAIMS 40-41 UNDER 35 U.S.C. § 103(A) AS BEING UNPATENTABLE OVER FERSTENBERG ET AL. IN VIEW OF CRAIN'S NEW YORK BUSINESS.

As to the applicability of Ferstenberg to the instant patent application, Applicant hereby incorporates by reference the arguments under Issue 1 above as if that argument were fully set forth herein.

The Examiner states that Crains's discloses "that intellectual property can be sold in a computer-implemented method and that the intellectual property can be patents, trademarks or copyrights at the Abstract." But there is no motivation or suggestion either in Ferstenberg or in Crain's to combine the two references in the manner the Examiner combines to deem claims 40-41 unpatentable. These claims are dependent on the independent claim 7, which is believed to be patentable in view of the discussion presented with respect to that claim in Issue 1. In addition, because the examiner showed no evidence that intellectual property can be marketed in an electronic marketplace in the manner claimed in claim 1, it is submitted that claims 40-41 would not have been obvious to one of skill in the art at the time the instant invention is made. The Board is requested to reverse and remand.

ISSUE 9: THE EXAMINER ERRED IN REJECTING CLAIMS 42 AND 44 UNDER 35 U.S.C. § 103(A) AS BEING UNPATENTABLE OVER HARRINGTON ET AL. IN VIEW OF BRETT ET AL.

As to the applicability of Ferstenberg to the instant patent application, Applicant hereby incorporates by reference the arguments under Issue 1 above as if that argument were fully set forth herein.

The only reason the Examiner combined Ferstenberg with Brett is that Brett described an online ticket sales. Thus, Examiner believes that Brett rendered claims 42 and 44 were rendered obvious because, a ticket is a license or a right to use a place, and therefore all the claims are rendered obvious in view of Brett. Applicant respectfully disagrees because no motivation or suggestion to combine Ferstenberg with Brett is provided within the references themselves, and because Examiner engaged in a hindsight reconstruction of the claims from the references, which is not the proper method of examination. The Board is requested to reverse. In the alternative that the Board agrees with the Examiner, Applicant respectfully requests leave to strike those portions of these claims and present them in such a way as to permit further examination or allowance.

ISSUE 10: THE EXAMINER ERRED IN REJECTING CLAIM 43 UNDER 35 U.S.C. § 103(A) AS BEING UNPATENTABLE OVER HARRINGTON ET AL. IN VIEW OF STALLAERT ET AL.

As to the applicability of Ferstenberg to the instant patent application, Applicant hereby incorporates by reference the arguments under Issue 1 above as if that argument were fully set forth herein.

Stallaert et al describes the patented method as follows.

The present invention allows market participants to exchange bundles of assets, including assets in different asset classes. A market participant may value the bundle as an entity, alleviating the need to attempt to attain a value objective in the aggregate by valuing and trading assets individually. A bundle of assets to be traded is entered, wherein proportions of each asset to be traded in units of a specified bundle size are provided by the market participant. Assets to be acquired by one market participant are matched against the same asset which other market participants are seeking to dispose. An exchange of bundled assets among market participants, in units of the bundles themselves is effected when the exchange satisfies a predetermined set of criteria.


Nowhere does Stallaert use the word “intangible.” Stallaert uses the word “share” to mean a portion of the seller’s commission and not in the manner that is described in the instant application. Stallaert does not does not disclose or claim any of the features of the rejected claim 43, which states that the bundle of rights sold could be with respect to a person, place or a thing. Examiner incorrectly argues that it would have been obvious to one of skill in the art at the time of the invention of claim 43 based on a combination of Stallaert and Ferstenberg. The Board is requested to reverse and remand.

CONCLUSION

For the reasons given, the references, even if combined, do not provide the benefits offered by Applicant’s invention, *i.e.*, an electronic marketplace for certain unconventional intangible property interests, personal rights and special commodities and shares thereof. Applicant respectfully submits the Examiner’s rejection of claims 7-44 should be reversed, and, accordingly, requests such action.

Respectfully submitted,

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I certify that the foregoing brief and all papers referenced herein are mailed via first class mail to the following address on April 2, 2004.

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Commissioner for Patents
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Alexandria, VA 22313-1450


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APPENDIX

Claims 1-6. (previously cancelled).

7. (previously added) A computer-implemented method of marketing an intangible property interest, the method comprising the steps of:

establishing an electronic marketplace; assigning an identifier to said intangible property interest; storing the identifier;

receiving a bid for purchase of said intangible property interest; and

selling said intangible property interest.

8. (previously added) The method of claim 7, wherein said intangible property interest is an interest in an intellectual property asset.

9. (previously added) The method of claim 8, wherein said intellectual property asset is selected from the group consisting of:

patent; trademark; and copyright.

10. (previously added) The method of claim 7, wherein said intangible property interest is selected from the group consisting of:

license; lease; easement; and goodwill.

11. (previously added) The method of claim 7, wherein said intangible property interest is a right included in a bundle of rights with respect to a person, place or a thing.

12. (previously added) The method of claim 11, wherein said right is selected from the group consisting of:

right to a unit of service;

right to income from a unit of service;
right to the use of an object;
right to income from an object;
right to the use of a place;
right to income from a place;
right of way;
right to navigate along a route;
right to use of genetic information;
right to income of a person for a period of time;
right to a person's time;
right to a person's ability, image or likeness;
right to bring lawsuit against a party;
right to collect a payment from a party;
right to profits from a partnership;
right to exclude an entity from making, using, selling, or importing a product; and
right to exclude an entity from making, using, selling, or importing a product made of a method.

13. (previously added) The method of claim 7, wherein said intangible property interest is an interest derived from a second intangible property interest.

14. (previously added) The method of claim 7, wherein said intangible property interest is a share of a second intangible property interest.

15. (previously added) The method of claim 7, further comprising the step of:
displaying the identifier or a description of said intangible property interest.

16. (previously added) The method of claim 7, further comprising the step of:

inviting a seller to register an intangible property interest.

17. (previously added) The method of claim 7, further comprising the step of:
registering an intangible property interest.

18. (previously added) The method of claim 7, further comprising the step of:
computing the price of said intangible property interest.

19. (previously added) The method of claim 18, wherein the step of computing the price of said intangible property interest includes the step of:
computing the price using Black-Scholes formula.

20. (previously added) The method of claim 7, further comprising the step of:
displaying an ask price for said intangible property interest.

21. (previously added) The method of claim 7, further comprising the step of:
matching the bid with an ask price.

22. (previously added) The method of claim 7, further comprising the step of:
offering for sale a share in said intangible property interest,

23. (previously added) The method of claim 7, wherein the electronic marketplace comprises a programmed computer coupled to a communication network.

24. (previously added) A method of marketing an intangible property interest on an electronic marketplace, the method comprising the steps of:
registering said intangible property interest with the electronic marketplace;

displaying an identifier or a description of said intangible property interest;
receiving a bid from a buyer for purchase of said intangible property
interest;

selling said intangible property interest to the buyer.

25. (previously added) The method of claim 24, further comprising the step of:
offering for sale a share of an intangible property interest.

26. (previously added) The method of claim 24, wherein said intangible
property interest is an interest in an intellectual property asset.

27. (previously added) The method of claim 26, wherein said intellectual
property asset is selected from the group consisting of:
patent; trademark; and copyright.

28. (previously added) The method of claim 24, wherein said intangible
property interest is selected from the group consisting of:
license; lease; easement; and goodwill.

29. (previously added) The method of claim 24, wherein said intangible
property interest is a right included in a bundle of rights with respect to a person,
place or a thing.

30. (previously added) The method of claim 29, wherein the right is selected
from the group consisting of:
right to a unit of service;
right to income from a unit of service;
right to the use of an object;
right to income from an object;

right to the use of a place;
right to income from a place;
right of way;
right to navigate along a route;
right to use of genetic information;
right to income of a person for a period of time;
right to a person's time;
right to a person's ability, image or likeness;
right to bring lawsuit against a party;
right to collect a payment from a party;
right to profits from a partnership;
right to exclude an entity from making, using, selling, or importing a product; and
right to exclude an entity from making, using, selling, or importing a product made of a method.

31. (previously added) The method of claim 24, farther comprising the steps of:
computing income derived from said intangible property interest; and
disbursing a portion of the income to the buyer.

32. (previously added) The method of claim 24, wherein said intangible property interest is an interest derived from a second intangible property interest.

33. (previously added) A record of an investment portfolio stored on a computer-readable medium, said investment portfolio comprising at least one intangible property interest.

34. (previously added) The record as in claim 33, wherein said intangible property interest is an interest in an intellectual property asset.

35. (previously added) The record as in claim 33, wherein said intellectual property asset is selected from the group consisting of
patent; trademark; and copyright.

36. (previously added) The record as in claim 33, wherein said intangible property interest is selected from the group consisting of:
license; lease; easement; and goodwill.

37. (previously added) The record as in claim 33, wherein said intangible property interest is at least one right included in a bundle of rights with respect to a person, place or a thing.

38. (previously added) The record as in claim 37, wherein said at least one right is selected from the group consisting of:

- right to a unit of service;
- right to income from a unit of service;
- right to the use of an object;
- right to income from an object;
- right to the use of a place;
- right to income from a place;
- right of way;
- right to navigate along a route;
- right to use of genetic information;
- right to income of a person for a period of time;
- right to a person's time;
- right to a person's ability, image or likeness;
- right to bring lawsuit against a party;
- right to collect a payment from a party;

right to profits from a partnership;
right to exclude an entity from making, using, selling, or importing a product; and
right to exclude an entity from making, using, selling, or importing a product made of a method.

39. (previously amended) A computer-implemented method of selling a share of ownership in an intangible property interest, the method comprising the steps of:

computing a plurality of shares in an intangible property interest;
outputting a prospectus for shares in said intangible property interest;
computing a price for a share of said intangible property interest;
receiving a bid for a first share of said intangible property interest;
selling the first share in said intangible property interest to a buyer; and
storing on a computer-readable medium the buyer's ownership interest in the share of said intangible property interest.

40. (previously added) The method of claim 39, wherein said intangible property interest is an interest in an intellectual property asset.

41. (previously added) The method of claim 40, wherein said intellectual property interest is selected from the group consisting of:

patent; trademark and copyright.

42. (previously added) The method of claim 39, wherein said intangible property interest is selected from the group consisting of:

license; lease; easement; and goodwill.

43. (previously added) The method of claim 39, wherein said intangible property interest is a right included in a bundle of rights with respect to a person, place or a thing.

44. (previously added) The method of claim 43, wherein the right is selected from the group consisting of:

- right to a unit of service;

- right to income from a unit of service;

- right to the use of an object;

- right to income from an object;

- right to the use of a place;

- right to income from a place;

- right of way;

- right to navigate along a route;

- right to use of genetic information;

- right to income of a person for a period of time;

- right to a person's time;

- right to a person's ability, image or likeness;

- right to bring lawsuit against a party;

- right to collect a payment from a party;

- right to profits from a partnership;

- right to exclude an entity from making, using, selling, or importing a product; and

- right to exclude an entity from making, using, selling, or importing a product made of a method.